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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,871	02/04/2004	Joseph W. Pieczynski II	2108.003600	3761
45488 7590 03/30/2007 WILLIAMS, MORGAN & AMERSON 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/771,871

Applicant(s)

PIECZYNSKI ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-38, 40-43, 45 and 57-59 is/are allowed.
- 6) ☒ Claim(s) 1-23, 25, 27-32, 39, 44, 46-51 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 24, 26, 33, 52 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05/17/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference number 65 was not listed in the specification. The examiner recommends the applicant review the specification and drawings for any additional reference numbers not listed in the specification or shown in the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly

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those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because the abstract contains more than 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12, 16, 18, 25, 39, 44, 46, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 12 recites the limitation "said drill guides" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 25, 39, 44, 46, and 47 have similar antecedent basis insufficiencies. The examiner recommends the applicant review the claims for any additional antecedent basis insufficiencies.
7. Claim 16 recites the limitation "said bottom surface of said cradle assembly" in line 3. There is insufficient antecedent basis for this limitation in the claim. For

examination purposes, the examiner will understand the claim to read as the bottom surface of the body of the device.

8. Claim 18 states, "wherein said tip may be moved in a direction...", the examiner is unclear if the above portion of claim 18 is a necessary limitation for the tip. For examination purposes, the examiner will understand the limitation as functional language and not a limiting characteristic for the tip.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 11-13, and 46-48 are rejected under 35 U.S.C. 102(b) as being anticipated by McGuire (U.S. Patent 3,835,849).

Regarding claim 1, McGuire discloses a device comprising a body that includes a bottom surface and a moveable stylus that includes a tip and is operatively coupled to the body. The stylus is capable of being moved in a direction that is approximately perpendicular to a plane containing the bottom surface of the device. Regarding claim 11, McGuire discloses a device further comprising a plurality of individually positionable drill guides couple to the body of the device. Regarding claim 12, McGuire discloses a device wherein each of the drill guides are capable of being used as a guide for a femur post hole being formed in a femur. Regarding claim 13, McGuire discloses a device wherein each of the individually positionable drill guides is positioned on a moveable

body that is positioned in a recess formed in a top surface of the body. Regarding claim 46, McGuire discloses a device comprising a body having a bottom surface and a plurality of individually positionable drill guides couple to the body, wherein each drill guides may be individually positioned independent of each other. Regarding claim 47, McGuire discloses a device wherein each of the drill guides are capable of being used as a guide for a femur post hole being formed in a femur. Regarding claim 48, McGuire discloses a device wherein each of the individually positionable drill guides is positioned on a moveable body that is positioned in a recess formed in a top surface of the body.

11. Claims 1-9, 14-22, 27-31, 49-51, and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw (U.S. Patent 6,290,704).

Regarding claim 1, Burkinshaw discloses a device comprising a body having a bottom surface and a moveable stylus that includes a tip and is operatively coupled to the body of the device, wherein the stylus is capable of being moved in a direction that is approximately perpendicular to a plane containing the bottom surface of the device. Regarding claim 2, Burkinshaw discloses a device wherein the body further comprises a plurality of protruding feet. Regarding claim 3, Burkinshaw discloses a device wherein the stylus further includes a shaft that is coupled to the tip of the stylus. Burkinshaw further shows the shaft having a handle that is operatively coupled to the shaft of the stylus such that rotation of the handle can rotate the tip of the stylus. Regarding claim 4, Burkinshaw discloses a device wherein the tip of the stylus is also capable of being moved in a direction that is substantially parallel to a plane containing the bottom surface. Regarding claim 5, Burkinshaw discloses a device wherein the shaft of the

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stylus is positioned in a sleeve. The sleeve is coupled to a moveable cradle assembly.

Regarding claim 6, Burkinshaw discloses a device wherein the moveable cradle assembly is coupled to the body of the device by a plurality of shafts. Each of the shafts is capable of sliding within openings located in the body of the device. Regarding claim 7, Burkinshaw discloses a device wherein the stylus has a shaft coupled to the tip and further comprising a cradle assembly. The cradle assembly includes a cross-member, a plurality of shafts coupled to the cross-member and being capable of sliding within openings located in the body of the device, and a sleeve that is pivotally coupled to the cross-member and wherein the shaft of the stylus is positioned within the sleeve.

Regarding claim 8, Burkinshaw discloses a device wherein the shafts of the cradle assembly include a plurality of size gradation marks positioned thereon. Regarding claim 9, Burkinshaw discloses a device wherein the stylus has a shaft coupled to the tip and further comprising a cradle assembly. The cradle assembly includes a cross-member, a plurality of shafts coupled to the cross-member and being capable of sliding within openings located in the body of the device, and a sleeve that is coupled to the cross-member and wherein the shaft of the stylus is positioned within the sleeve.

Regarding claim 14, Burkinshaw discloses a device comprising a body having a bottom surface and a moveable cradle assembly. The moveable cradle assembly includes a cross-member, a plurality of shafts slidably coupling the cross-member to the body, and a stylus operatively coupled to the cross-member. Regarding claim 15, Burkinshaw discloses a device wherein each of the shafts are capable of sliding within an opening located in the body of the device. Regarding claim 16, Burkinshaw discloses a device

wherein the stylus further includes a tip, wherein the tip is capable of moving in a direction that is approximately parallel to a plane containing the bottom surface of the device. Regarding claim 17, Burkinshaw discloses a device wherein the stylus further includes a tip, wherein the tip is capable of moving in a direction that is approximately parallel to a plane containing the bottom surface the device by movement of the shafts that are coupled to the cross-member within the openings of the body. Regarding claim 18, Burkinshaw discloses a device wherein the tip may be moved in a direction that is approximately perpendicular to a plane containing the bottom surface of the device. Regarding claim 19, Burkinshaw discloses a device wherein the body further comprises a plurality of feet. Regarding claim 20, Burkinshaw discloses a device wherein the stylus further comprises a tip, a shaft coupled to the tip, and a handle that is operatively coupled to the shaft, wherein rotation of the handle causes rotation of the tip. Regarding claim 21, Burkinshaw discloses a device wherein the stylus further comprises a tip, a shaft coupled to the tip, and a sleeve that is pivotally coupled to the cross-member of the cradle assembly, wherein the shaft is positioned within the sleeve. Regarding claim 22, Burkinshaw discloses a device wherein the shafts slidably coupled to the cross-member have a plurality of size gradation marks positioned thereon. Regarding claim 27, the applicant invoked U.S.C. 112 6<sup>th</sup> paragraph with a "means for" limitation in the claim. The examiner is required to reference the specification for the corresponding structure performing the function in the claim. The examiner believes the "means for" limitation is referenced in the specification on page 23 lines 2-8 regarding a sleeve. Therefore, the examiner will understand the "means for" language of claim 27 to



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reference a sleeve. Regarding claim 27, Burkinshaw discloses a device comprising a body having a bottom surface, a stylus with a tip, and a sleeve capable of moving the tip of the stylus in a direction that is approximately perpendicular to a plane containing the bottom surface of the body of the device. Regarding claim 28, the applicant invoked U.S.C. 112 6<sup>th</sup> paragraph with a "means for" limitation in the claim. The examiner is required to reference the specification for the corresponding structure performing the function in the claim. The examiner believes the "means for" limitation is referenced in the specification on page 23 lines 8-14 regarding a cradle assembly. Therefore, the examiner will understand the "means for" language of claim 28 to reference a cradle assembly. Regarding claim 28, Burkinshaw discloses a device further comprising a cradle assembly capable of moving the tip of the stylus in a direction that is approximately parallel to a plane containing the bottom surface of the body. Regarding claim 29, Burkinshaw discloses a device wherein the body further comprises a plurality of protruding feet. Regarding claim 30, the applicant does not invoke U.S.C. 112 6<sup>th</sup> paragraph with the "means for" limitation in the claim because the claim does not meet the criteria of the three-prong analysis because the applicant modifies the "means for" phrase with sufficient structure for achieving the function. Regarding claim 30, Burkinshaw discloses a device comprising a sleeve that is capable of having a stylus positioned within, a sleeve having an axis that is approximately perpendicular to a plane containing the bottom surface of the body, and a handle coupled to the stylus. Regarding claim 31, the applicant does not invoke U.S.C. 112 6<sup>th</sup> paragraph with the "means for" limitation in the claim because the claim does not meet the criteria of the

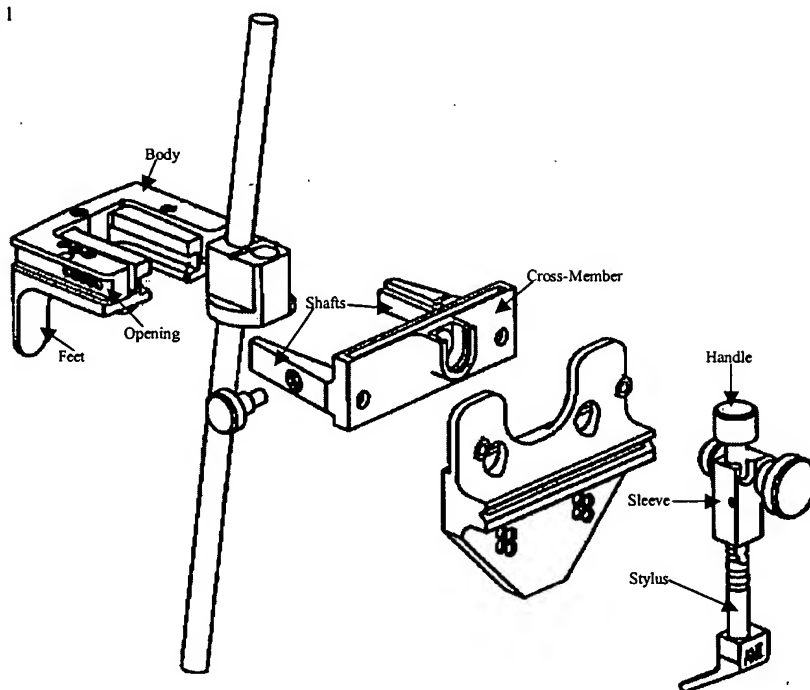
three-prong analysis because the applicant modifies the “means for” phrase with sufficient structure for achieving the function. Regarding claim 31, Burkinshaw discloses a device comprising a cradle assembly, wherein the cradle assembly includes a cross-member operatively coupled to the stylus and a plurality of shafts coupled to the cross-member and capable of being slidably positioned within openings formed in the body of the device. Regarding claim 49, Burkinshaw discloses a device that can inherently be used by a method comprising the steps of making an incision in a patient's knee, attaching a femoral implant sizing guide to a prepared surface of a femur of the patient, wherein the sizing guide has a body with a bottom surface and a moveable stylus with a tip, after said sizing guide is attached to the femur, moving the tip of the stylus in both a direction that is approximately perpendicular to a plane containing the bottom surface and in a direction that is approximately parallel to a plane containing the bottom surface to position the tip of the stylus at a location proximate an anterior cortex region of the femur, and determining the size of a femoral knee prosthesis to be positioned on the femur. Regarding claim 50, the device used in Burkinshaw is used in part of a total knee arthroplasty, wherein the femur is prepared to receive a femoral reconstruction component or knee implant. Therefore the examiner believes Burkinshaw discloses a device that can be inherently used by a method as discussed above further including the step of attaching a femoral prosthesis of the determined size onto the femur, since the device is preparing the femur to receive such an implant. Regarding claim 51, Burkinshaw discloses a device that can inherently be used by a method as discussed above further comprising the step of rotating the tip of the stylus. Regarding claim 53,

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Burkinshaw discloses a device that can inherently be used by a method comprising the steps of making an incision in a patient's knee, attaching a femoral implant sizing guide to a prepared surface of a femur of the patient, wherein the sizing guide has a body with a bottom surface, a moveable stylus with a tip, and a cradle assembly that includes a cross-member and a plurality of shafts coupling the cross-member to the body, after said sizing guide is attached to the femur, moving the tip of the stylus in both a direction that is approximately perpendicular to a plane containing the bottom surface and in a direction that is approximately parallel to a plane containing the bottom surface to position the tip of the stylus at a location proximate an anterior cortex region of the femur, and determining the size of a femoral knee prosthesis to be positioned on the femur. Regarding claim 54, the device used in Burkinshaw is used in part of a total knee arthroplasty, wherein the femur is prepared to receive a femoral reconstruction component or knee implant. Therefore the examiner believes Burkinshaw discloses a device that can be inherently used by a method as discussed above further including the step of attaching a femoral prosthesis of the determined size onto the femur, since the device is preparing the femur to receive such an implant. Regarding claim 55, Burkinshaw discloses a device that can inherently be used by a method as discussed above further comprising the step of rotating the tip of the stylus.

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Figure 1



### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10, 23, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burkinshaw (U.S. Patent 6,290,704) in view of Mumme (U.S. Patent 5,423,827).

Regarding claims 10, 23, and 32, Burkinshaw discloses the invention as claimed except for the device comprising a plurality of retractable nails that are capable of being in a retracted position so that the tips do not extend beyond the bottom surface of the

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device. Mumme teaches a device comprising retractable nails that are capable of being in a retracted position so that the tips do not extend beyond the bottom surface of the device in order to temporarily stabilize the device (column 2 lines 67-68 and column 3 lines 1-9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Burkinshaw further comprising retractable nails that are capable of being in a retracted position so that the tips do not extend beyond the bottom surface of the device in view of Mumme in order to temporarily stabilize the device.

***Allowable Subject Matter***

14. Claims 34-38, 40-43, 45 and 57-59 are allowed.
15. Claims 24, 26, 33, 52, and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
16. Claims 25, 39, and 44 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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